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**Request
For
Continued Examination (RCE)
Transmittal**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995.
See The American Inventors Protection Act of 1999 (AIPA).

Application Number	09/029,579
Filing Date	May 6, 1998
First Named Inventor	Landegren, U.
Group Art Unit	1636
Examiner Name	Gansheroff, L.
Attorney Docket Number	66805/RFT/NBC

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.
NOTE: 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. § 1.114**

- a. ☒ Previously submitted
- i. ☒ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on June 5, 2001
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- b. ☒ Enclosed
- i. ☐ Petition to Revive Unintentionally Abandoned Application
- ii. ☐ Notice of Appeal
- iii. ☒ Petition for Four Month Extension of Time

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)

3. **Fees** The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 60-1300 (order no. A-66805/RFT/NBC)
- i. ☐ RCE fee required under 37 C.F.R. § 1.17(e)
- ii. ☐ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☒ Other :any additional fees charge to Deposit Account No. 06-1300 (A-66805/RFT/NBC)
- b. ☒ Check in the amount of \$ 1,090.00 inclusive of the RCE Filing Fee, is enclosed (RCE Filing Fee \$370.00; Four Month Extension Fee \$720.00)
- c. ☐ Check in the amount of \$ _____ (One month extension fee) is enclosed
- d. ☐ Payment by credit card (Form PTO-2038 enclosed)

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print Type)	Richard F. Trecartin	Registration No. 31,801 (Attorney/Agent)	
Signature		Date December 10, 2001	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner For Patents, Box RCE, Washington, DC 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on:

Name (Print Type)	Gail Diehl		
Signature		Date	December 10, 2001

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1/28/02
PATENT

Attorney Docket No.: A-66805/RFT/NBC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Ulf Landegren

Examiner: Gansheroff, L.

Group Art Unit: 1636

Serial No. 09/029,579

Filed: May 6, 1998

For: *Methods and
Compositions for Nucleic
Acid Targeting*

CERTIFICATE OF MAILING
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RESPONSE TO ADVISORY ACTION

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicant has carefully considered the Advisory Action mailed August 16, 2001 in connection with the above-captioned application. In light of Examiner's arguments, Applicant requests that Examiner cancel original claims 1-6 without prejudice and consider amended claim 7 along with new claims 8-12 set out in Applicant's Amendment filed June 5, 2001 and referenced in Applicant's Request for Continued Examination (RCE) filed in conjunction with this Response. Additionally accompanying this Response is a Petition for Extension of Time extending the period for response by four months, up to and including ***December 10, 2001.***

Right of Priority Under 35 U.S.C. 365

Applicant states that the above-referenced application is entitled to a priority date of September 8, 1995 pursuant to 35 U.S.C. 365(b) which provides that an international application designating the United States is allowed a right of priority to a prior foreign application that is filed in a foreign country. Application PCT/SE96/01119, filed September 6, 1996, designates the present application under 35 U.S.C. 371 (see attached Notification of Acceptance). Application PCT/SE96/01119 further claims priority to Swedish National Application 9,503,117-5, filed September 8, 1995 (see attached declaration executed April 21, 1998). Since Application PCT/SE96/01119 designating the

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present application claims priority to Swedish National Application 9,503,117-5 under 35 U.S.C. 365(b), the present application is entitled to the September 8, 1995 priority date afforded Application PCT/SE96/01119, rather than the September 6, 1996 PCT filing date asserted by Examiner. Applicant's claim to priority was properly perfected in the present application pursuant to 35 U.S.C. 119(a)-(d) (see attached filing receipt) and thus Applicant is entitled to the benefit of the September 8, 1995 filing date of Swedish Application 9,503,117-5.

The *Nilsson et al.* publication, entitled "Padlock Probes: Circularizing Oligonucleotides for Localized DNA Detection" *Science* 265:2085-2088 cannot properly be cited as the basis for a 35 U.S.C. § 102(b) prior art rejection of claim 7, since the September 30, 1994 publication date of *Nilsson* antedates the priority date of the present application by less than one year. The Examiner's rejection of claim 7 can, at best, be asserted under 35 U.S.C. § 102(a). The language of 35 U.S.C. § 102(a), however, requires that the *Nilsson* prior art reference be "by others," instead of by Applicant. The *Katz* Declaration submitted by Applicant in accordance with 37 CFR §1.132 (see attached declaration) unequivocally establishes that only Dr. Landegren conceived of the subject matter relied upon in the *Nilsson* prior art publication and that co-authors Nilsson, M., Malmgren, H., Samiotaki, S., Kwiakowski, M. and Chowdhary, B. acted solely under the supervision of Dr. Landegren and neither collaborated nor contributed to the subject matter of the *Nilsson* publication. For these reasons, the *Nilsson* publication cannot properly be cited as prior art against claim 7 under 35 U.S.C. § 102(a).

Accordingly, Applicant respectfully requests that Examiner withdraw the rejection of claim 7 under 35 U.S.C. § 102(a) as being anticipated by *Nilsson*. Applicant further requests that Examiner consider new claims 8-12 as previously submitted in the Amendment filed by Applicant on June 5, 2001. Such request has additionally been set forth in the Request for Continued Examination submitted herewith.

CONCLUSION

Applicant submits that all the claims are in condition for allowance and an early notification of such is solicited.